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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,784	10/16/2001	Toshiyasu Ito	04208.0112	8751
22852	7590	05/09/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			FIGUEROA, FELIX O	
			ART UNIT	PAPER NUMBER
			2833	

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/869,784

Applicant(s)

ITO ET AL.

Examiner

Felix O. Figueroa

Art Unit

2833

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 10, 2005 has been entered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

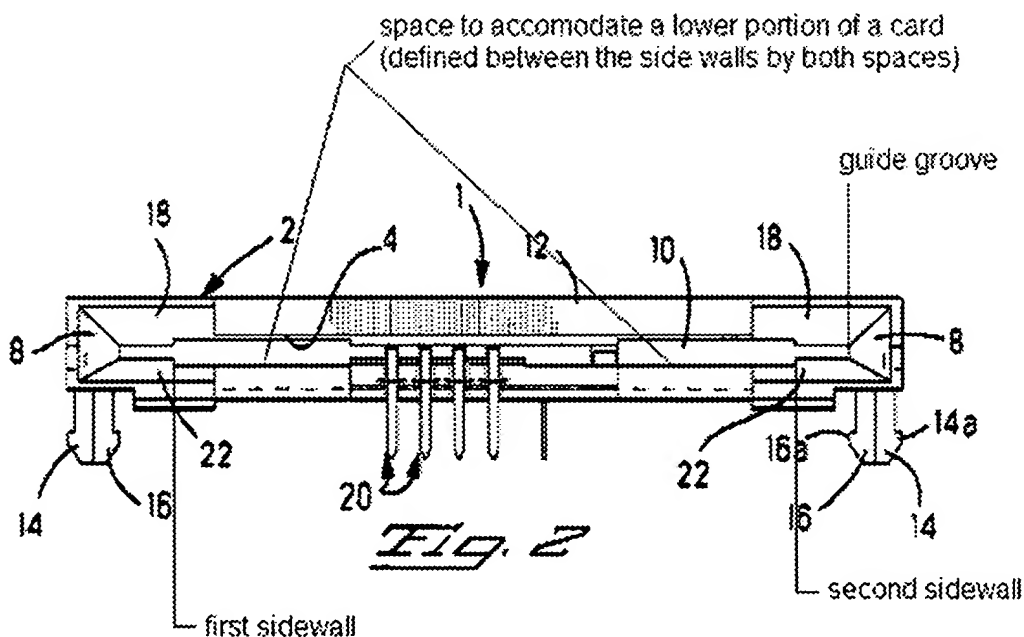
Claims 1, 2, 7, 8, 11, 12 and 14-22 and 25-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Asakawa (US 6,135,809).

Asakawa discloses a card connector configure to hold a first card and configure to hold a second card, and comprising: a pair of guide grooves (see following figure) formed on both sidewalls of a connector housing (2); and first and second sidewalls (see following figure), and a base plate with a plurality of contact terminals (20) arranged in the base plate to couple with contact of a bottom surface of a card.

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Asakawa also discloses a first space defined between the guide grooves, and a second space defined by the sidewalls; the second space (see following figure) located below the first space, and the second space configure to accommodate a lower portion of a first card.

Please note that the recitation that an element is "configured to" perform a function is not a positive limitation but only requires the ability to so perform. In this case, Asakawa discloses a second space that can accommodate the lower portion of an appropriate first card. Additionally, it is noted that recitations of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).



Regarding claims 2, 12 and 22, Asakawa discloses the sidewalls formed at such locations that they can guide the side surfaces of a lower body portion of a first card (C).

Regarding claims 5, 6, 15, 25 and 26 Asakawa discloses a housing top plate that forms upper walls of the guide grooves is formed with an opening / a recess (adjacent 12) having a width larger than a lower body portion of a first card, i.e. a least the same size as the separation between the side walls.

Regarding claims 7, 8, 11, 17, 18, 27 and 28, please note that the terminals 50 work as a braking piece.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 9, 10, 13, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asakawa in view of Horie (US 6,231,360).

Asakawa discloses substantially the claimed invention except for the eject mechanism. Horie teaches a card connector having an ejector mechanism (11) to help withdraw a card from the socket. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the card connector of Asakawa having an ejector mechanism, as taught by Horie, to help withdraw a card from the socket.

Regarding claim 4, Asakawa discloses the braking piece secure to a position which is far part of the guide groove.

### ***Response to Arguments***

Applicant's arguments that Asakawa does not "defined by the first and second side walls" have been considered but are moot in view of the new grounds of rejection. Please note that the space is defined by both spaces as shown in the earlier presented figure.

In response to Applicant's arguments that "[a]ny card that would fit 'on either side of partition 28,' however, would not have 'stepped portions formed along both side edges of the card,' as recited in claims 1 and 11", please note that because of the location of the guide grooves and the side walls, a portion of a card fitting in the second space requires to be stepped relative to the edges of the card receive in the guide grooves.

In response to Applicant's arguments that "the recitation of the configuration of the second space constitutes a structural claim element, which should receive patentable weight", it is noted that this limitation has been afforded patentable weight. Please note that the limitation is presented as "an intended use" limitation. Accordingly, any structural restriction or difference define by such language is considered. In this case, the card connector of Asakawa is configured to accommodate lower body portion of a card having stepped portions formed along both side edges of the card.

In response to Applicant's arguments that does Asakawa "does not constitute 'an enabling description of the desired subject matter.' (See MPEP 52121.01.)" because

Asakawa "does not describe first and second cards", please note that the claim language does not positively recite the first and second cards, but rather a connector configured to hold first and second card. In this case, Asakawa discloses a card connector that is configured to hold first and second cards, as required by the claim language.

In response to Applicant's arguments that the contact 50 are not "arranged at such a position that the elastic braking piece engages the bottom surface of the upper body portion of said first card when said first card is inserted and engages the bottom surface of the card body portion of said second card when said second card is inserted," please note that Asakawa discloses (in Figs. 5B and 5C) the contact 50 contacting the bottom surface of the upper body portion. Please note that even if the braking piece 50 contacts a terminal, such terminal is located on the bottom surface and thus is considered part of that bottom surface.

In response to Applicant's arguments against Horie, please note that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

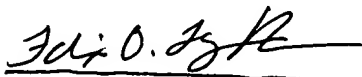
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felix O. Figueroa whose telephone number is (571) 272-2003. The examiner can normally be reached on Mon.-Fri., 10:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (571) 272-2800 Ext. 33. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ffr

  
Felix O. Figueroa  
AU. 2833